



[3510-16]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 2

[Docket No. PTO-T-2010-0016]

RIN 0651-AC41

Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office or USPTO) proposes to amend its rules regarding petitions to revive an abandoned application and petitions to the Director of the USPTO (Director) regarding other matters, and to codify USPTO practice regarding requests for reinstatement of abandoned applications and cancelled or expired registrations. The proposed changes will permit the USPTO to provide more detailed procedures regarding the deadlines and requirements for requesting

revival, reinstatement, or other action by the Director. These rules will thereby ensure that the public has notice of the deadlines and requirements for making such requests, facilitate the efficient and consistent processing of such requests, and promote the integrity of application/registration information in the trademark electronic records system as an accurate reflection of the status of applications and registrations.

DATES: Comments must be received by [Insert date 60 days from the date of publication in the Federal Register] to ensure consideration.

ADDRESSES: The USPTO prefers that comments be submitted via electronic mail message to TMFRNotices@uspto.gov. Written comments also may be submitted by mail to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention Jennifer Chicoski; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, VA 22314, attention Jennifer Chicoski; or by electronic mail message via the Federal eRulemaking Portal at <http://www.regulations.gov>. See the Federal eRulemaking Portal Web site for additional instructions on providing comments via the Federal eRulemaking Portal. All comments submitted directly to the USPTO or provided on the Federal eRulemaking Portal should include the docket number (PTO-T-2010-0016).

The comments will be available for public inspection on the USPTO's Web site at <http://www.uspto.gov>, on the Federal eRulemaking Portal, and at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, VA 22314. Because comments will be made available for public inspection,

information that is not desired to be made public, such as an address or phone number, should not be included.

FOR FURTHER INFORMATION CONTACT: Jennifer Chicoski, Office of the Deputy Commissioner for Trademark Examination Policy, by e-mail at TMPolicy@uspto.gov, or by telephone at (571) 272-8943.

SUPPLEMENTARY INFORMATION

Purpose: The USPTO proposes to revise the rules in part 2 of title 37 of the Code of Federal Regulations to provide more detailed procedures regarding the deadlines and requirements for petitions to revive an abandoned application under 37 CFR 2.66 and petitions to the Director under 37 CFR 2.146. The proposed changes also codify USPTO practice regarding requests for reinstatement of applications that were abandoned, and registrations that were cancelled or expired, due to Office error. By providing more detailed procedures regarding requesting revival, reinstatement, or other action by the Director, the proposed rule will benefit applicants, registrants, and the public because it will promote the integrity of application/registration information in the trademark electronic records system as an accurate reflection of the status of live applications and registrations, clarify the time periods in which applications or registrations can be revived or reinstated after abandonment or cancellation as well as inform of the related filing requirements, clarify the deadline for requesting that the Director take action regarding other matters, and facilitate the efficient and consistent handling of such requests.

The public relies on the trademark electronic records system to determine whether a chosen mark is available for use or registration. Applicants are encouraged to utilize

the trademark electronic search system, which provides access to text and images of marks, to determine whether a mark in any pending application or current registration is similar to their mark and used on the same or related products or for the same or related services. The search system also indicates the status of an application or registration, that is, whether the application or registration is live or dead. A “live” status indicates the application or registration is active and may bar the registration of a similar mark in a new application. A “dead” status indicates the application has become abandoned or the registration is cancelled or expired, and does not serve as a bar to registration of a similar mark in a new application unless it is restored to a live status pursuant to a corresponding rule.

When a party’s search discloses a potentially confusingly similar mark, that party may incur a variety of resulting costs and burdens, such as those associated with investigating the actual use of the disclosed mark to assess any conflict, proceedings to cancel the registration or oppose the application of the disclosed mark, civil litigation to resolve a dispute over the mark, or changing plans to avoid use of the party’s chosen mark. In order to determine whether to undertake one or more of these actions, the party would refer to the status of the conflicting application/registration and would need to consult the relevant rule to determine whether the application or registration is within the time period in which the applicant or registrant may request revival, reinstatement, or other action by the Director. Thus, the effective notice provided by the USPTO’s records plays a critical role in a party’s decision-making to clearly distinguish between the “dead” marks that are no longer candidates for, or protected by, a federal registration and those that are still able to be restored to active status.

The USPTO estimates that it receives annually approximately 20,000 petitions to revive an application under § 2.66 abandoned for failure to respond to an Office action or a notice of allowance, 1,200 petitions to the Director under § 2.146, and 300 requests for reinstatement of applications and registrations. If the trademark electronic records system indicates that an application or registration is dead because it is abandoned, cancelled, or expired, and there is any doubt as to whether the application or registration might be eligible for revival, reinstatement, or other action by the Director, the costs and burdens discussed above may be incurred unnecessarily. By providing more detailed procedures as to the deadlines and requirements for requesting revival, reinstatement, or other action by the Director, the proposed rules will help the public avoid such needless costs and burdens and promote the efficient and consistent processing of such requests by the Office.

Background

Petition to Revive: The statutory period for responding to an examining attorney's Office action is six months from the Office action's date of issuance. 15 U.S.C. 1062(b); 37 CFR 2.62(a). If no response is received by the USPTO within the statutory period, and the Office action was sent to the correspondence address in the USPTO's records, the application is then abandoned in full or in part, as appropriate. 37 CFR 2.65(a); Trademark Manual of Examining Procedure (TMEP) § 718.06.

The statutory period for filing a statement of use, or a request for an extension of time to file a statement of use, in response to a notice of allowance issued under section 1063(b)(2) of the Trademark Act (Act), is also six months. 15 U.S.C. 1051(d)(1), (2); 37 CFR 2.88(a), 2.89(a). Thus, an application is abandoned if the applicant fails to file a

statement of use or request for an extension of time to file a statement of use within the statutory period or within a previously granted extension period. 37 CFR 2.88(k); TMEP § 718.04.

An application is considered to be abandoned as of the day after the date on which a response to an Office action or notice of allowance is due. However, to accommodate timely mailed paper submissions and to ensure that the required response was not received and placed in the record of another application (e.g., if the applicant enters the incorrect serial number on its response), the USPTO generally waits one month after the due date to update the trademark electronic records system to reflect the abandonment. TMEP § 718.06. When the trademark electronic records system is updated, the USPTO sends a computer-generated notice of abandonment to the correspondence address listed in the application. Id. If an application becomes abandoned for failure to respond to an Office action or notice of allowance within the statutory period, and the delay in responding was unintentional, the application may be revived upon proper submission of a petition under 37 CFR 2.66. Currently, the deadlines for filing the petition are within two months after the date of issuance of the notice of abandonment or within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment and the applicant was diligent in checking the status of the application every six months. 37 CFR 2.66(a).

Request for Reinstatement: Under current practice, if an applicant has proof that an application was inadvertently abandoned due to a USPTO error, an applicant may file a request to reinstate the application, instead of a petition to revive. TMEP § 1712.01. The following is a non-exhaustive list of examples of situations in which the USPTO may

reinstate an application held abandoned for failure to respond to an Office action or notice of allowance: (1) the applicant presents proof that a response to an Office action, statement of use, or request for extension of time to file a statement of use was timely filed through the Trademark Electronic Application System (TEAS); (2) there is an image of the timely filed response, statement of use, or extension request in the trademark electronic records system; or (3) the applicant supplies a copy of the document and proof that it was timely mailed to the USPTO in accordance with the requirements of 37 CFR 2.197. Id. Under current practice, a request for reinstatement must be filed within two months of the issuance date of the notice of abandonment. Id. If the applicant asserts that it did not receive a notice of abandonment, the request must be filed within two months of the date the applicant had actual knowledge that the application was abandoned, and the applicant must have been duly diligent in monitoring the status of the application every six months. Id.

Similarly, under current practice, a registrant may file a request to reinstate a cancelled or expired registration if the registrant has proof that a required document was timely filed and that USPTO error caused the registration to be cancelled or expired. TMEP § 1712.02. The following is a non-exhaustive list of examples of situations in which the USPTO may reinstate a cancelled or expired registration: (1) the registrant presents proof that a required document was timely filed through TEAS; (2) the registrant presents proof of actual receipt of the required document in the USPTO in the form of a return postcard showing a timely USPTO date stamp or label, on which the registrant specifically refers to the document; or (3) the USPTO sent an Office action to the wrong address due to a USPTO error, i.e., the USPTO either entered the correspondence address

incorrectly or failed to enter a proper notice of change of address filed before the issuance date of the action. Id. There is currently no deadline for filing a request to reinstate a cancelled/expired registration and the USPTO has generally not invoked the requirement for due diligence when there is proof that a registration was cancelled or expired solely due to USPTO error. TMEP § 1712.02(a).

Petition to the Director Under 37 CFR 2.146: Applicants, registrants, and parties to inter partes proceedings before the Trademark Trial and Appeal Board (TTAB) who believe they have been injured by certain adverse actions of the USPTO, or who believe that they cannot comply with the requirements of the Trademark Rules of Practice (37 CFR Parts 2, 3, 6, and 7) because of an extraordinary situation, may seek equitable relief by filing a petition under 37 CFR 2.146. A variety of issues may be reviewed on petition under this section. Some of the more common examples are when a party petitions the Director to: (1) review an examining attorney's formal requirement, if the requirement is repeated or made final and the subject matter is appropriate for petition; (2) review the action of the Post Registration Unit refusing an affidavit of use or excusable nonuse under section 8 or section 71 of the Act, 15 U.S.C. 1058, 1141k, a renewal application under section 9 of the Act, 15 U.S.C. 1059, or a proposed amendment to a registration under section 7 of the Act, 15 U.S.C. 1057; or (3) review the refusal of the Madrid Processing Unit to certify an application for international registration. See TMEP § 1703. Generally, unless a specific deadline is specified elsewhere in the rules or within this section, such as the deadlines for petitions regarding actions of the TTAB under § 2.146(e), a petition must be filed within two months of the date of issuance of the action from which relief is requested and no later than two months

from the date when Office records are updated to show that a registration has been cancelled or has expired under § 2.146(d). However, under current § 2.146(i), if a petitioner seeks to reactivate an application or registration that was abandoned, cancelled, or expired because documents not received by the Office were lost or mishandled, the petitioner is also required to be duly diligent in checking the status of the application or registration. The section has traditionally been invoked when papers submitted pursuant to the mailing rules in § 2.197 and § 2.198 were lost. However, the occurrence of such incidents is minimal. Further, the USPTO believes that if an applicant or registrant has proof that documents mailed in accordance with the requirements of § 2.197 or § 2.198 were lost or mishandled by the USPTO, thereby causing the abandonment of an application or cancellation/expiration of a registration, the proper recourse will be to seek relief under the proposed rule for requesting reinstatement.

Establishing Due Diligence: As noted above, if an applicant or registrant does not receive a notice from the USPTO regarding the abandonment of its application, cancellation/expiration of its registration, or denial of some other request, but otherwise learns of the abandonment, cancellation/expiration, or denial, the applicant or registrant must have been duly diligent in tracking the status of its application or registration in order to be granted revival, reinstatement, or other action by the Director. Section 2.146(i) sets out the standard of due diligence for petitions to revive and to reactivate an application or registration that was abandoned, cancelled, or expired because documents were lost or mishandled. To be considered duly diligent, an applicant must check the status of the application at least every six months between the filing date of the application and issuance of a registration. 37 CFR 2.146(i)(1). After filing an affidavit

of use or excusable nonuse under section 8 or section 71 of the Act or a renewal application under section 9 of the Act, a registrant must check the status of the registration every six months until the registrant receives notice that the affidavit or renewal application has been accepted. 37 CFR 2.146(i)(2). Section 2.146(d) sets out the standard currently followed for requests to reinstate an application abandoned due to Office error. TMEP § 1712.01. When a party seeks to revive an application that was abandoned or reinstate a registration that was cancelled or expired, either due to the failure of the applicant or registrant to file a required document or to the loss or mishandling of documents sent to or from the USPTO, or asks the Director to take some other action, the USPTO may deny the request if the petitioner was not diligent in checking the status of the application or registration, even if the petitioner can show that the USPTO actually received documents, or declares that a notice from the USPTO was never received by the petitioner. 37 CFR 2.146(i).

The USPTO generally processes applications, responses, and other documents in the order in which they are received, and it is reasonable to expect some notice or acknowledgement from the USPTO regarding action on a pending matter within six months of the filing or receipt of a document. A party who has not received a notice or acknowledgement from the USPTO within that time frame has the burden of inquiring as to the status of action on its filing, and requesting in writing that corrective action be taken when necessary, to protect third parties who may be harmed by reliance on inaccurate information regarding the status of an application or registration in the trademark electronic records system. See TMEP § 1705.05. For example, a third party may have searched USPTO records and begun using a mark because the search showed

that an earlier-filed application, or prior registration, for a conflicting mark had been abandoned or cancelled. In other cases, an examining attorney may have searched USPTO records and approved for publication a later-filed application for a conflicting mark because the earlier-filed application was shown as abandoned or a prior registration was shown as cancelled.

The due-diligence requirement means that any petition filed more than two months after the notice of abandonment or cancellation was issued, or no later than two months after Office records are updated, is likely to be dismissed as untimely because the applicant or registrant will be unable to establish that it was duly diligent. For example, if an applicant files an application in July 1, 2016 and an Office action is issued on October 15, 2016, a response must be filed on or before April 15, 2017. If the applicant does not respond, the trademark electronic records system will be updated to show the application as abandoned and a notice of abandonment will be sent to the applicant on or about May 15, 2017. If the applicant does not receive the notice of abandonment, and only checks the trademark electronic records system in August 2017 (i.e., more than two months after the issue date of the notice of abandonment and more than a year after filing), and thereafter files a petition to revive, that petition would be denied as untimely. Even if the applicant asserts that it only became aware of the issuance of the Office action and the notice of abandonment on, for example, July 18, 2017 (actual notice), the petition would be denied as untimely because the applicant could not prove that it was duly diligent in monitoring the status of the application by checking the status every six months.

Moreover, in some situations when an applicant or owner of a registration asserts that it did not receive a notice of abandonment or cancellation, it is often difficult for the USPTO to determine when the party had actual notice of the abandonment/cancellation and whether the party was duly diligent in prosecuting the application or maintaining the registration. By effectively mandating that applicants and registrants conduct the requisite status checks of Office records every six months from the filing of a document, whether an application or a submission requesting action by the Office, parties would be aware of the acceptance or refusal of their submission with enough notice to timely respond in the vast majority of circumstances. For example, if a document is filed on January 2, and an Office action requiring a response within six months is issued on February 2, if the submitting party is duly diligent and reviews the trademark electronic records system on July 2, it would learn of the issuance of the action, even if the party did not receive it. In that situation, the party would still have one month in which to timely respond.

Discussion of Proposed Changes and Rulemaking Goals

Establish Certainty Regarding Timeliness: The goals of the proposed changes are to harmonize the deadlines for requesting revival, reinstatement, or other action by the Director and remove any uncertainty for applicants, registrants, third parties, and the Office as to whether a request is timely.

Under this proposed rule, the USPTO adds §§ 2.64(a)(1)(i) and (b)(1)(i) and amends §§ 2.66(a)(1) and 2.146(d)(1) to clarify that applicants and registrants would be on notice that if they receive an official document from the USPTO, such as a notice of abandonment or cancellation, a post-registration Office action, or a denial of certification

of an international registration, they must file a petition to revive, request for reinstatement, or petition to the Director to take another action, by not later than two months after the issue date of the notice. The proposed addition of §§ 2.64(a)(1)(i) and (b)(1)(i) codifies this deadline for parties seeking reinstatement of an application or registration abandoned or cancelled due to Office error and makes it consistent with the deadline in § 2.66(a)(1). The proposed amendment to § 2.66(a) clarifies that the deadline applies to abandonments in full or in part. Finally, the proposed change to § 2.146(d)(1) deletes the requirement that a petition be filed no later than two months from the date when Office records are updated to show that a registration is cancelled or expired. As noted below, this deadline is extended to not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired to harmonize the deadlines across the relevant sections.

To establish certainty and ensure consistency, the proposed rule also adds §§ 2.64(a)(1)(ii) and (b)(1)(ii) to codify the deadline for all applicants and registrants who assert that they did not receive an abandonment notice from the Office and thereafter seek reinstatement. This deadline is identical to the deadlines proposed in §§ 2.66(a)(2) and 2.146(d)(2) for applicants and registrants who assert that they did not receive a notice from the Office and thereafter seek relief. Under proposed §§ 2.64(a)(1)(ii) and (b)(1)(ii), if the applicant or registrant did not receive the notice, or no notice was issued, a petition must be filed by not later than two months of actual knowledge that a notice was issued or that an action was taken by the Office, and not later than six months after the date the trademark electronic records system is updated to indicate the action taken by the Office. Thus, this proposed rule makes clear that applicants and registrants must

check the status of their applications and registrations every six months and thereby remove any uncertainty in the Office's assessment of whether an applicant or registrant was duly diligent.

Balance Duties of USPTO to Registrants and Third Parties: Under this proposed rule, the USPTO would add § 2.64(b)(2)(ii) and amend § 2.146(d)(2)(ii) to include the requirement for due diligence in tracking the status of a registration. Registrants who seek reinstatement of a registration cancelled due to Office error, but who assert that they did not receive a notice of cancellation/expiration, must file the request by not later than two months of actual knowledge of the cancellation and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired.

As noted above, the USPTO has generally not invoked the requirement for due diligence when there is proof that a registration was cancelled or expired solely due to Office error. Although the USPTO has a duty to correct its errors, the USPTO has a concurrent duty toward third parties to ensure that the trademark electronic records system accurately reflects the status of applications and registrations, especially given that the USPTO encourages such third parties to search the trademark electronic records system prior to adopting or seeking to register a mark. Therefore, the USPTO must balance its duty to third parties who rely on the accuracy of the trademark electronic records system and to registrants whose registration may have been cancelled as a result of Office error. The USPTO believes that, in order to fulfill its duty to all parties, the requirement for due diligence should apply equally to registrants who did not receive a notice of cancellation/expiration and who request reinstatement of their registrations, as it

does to all other applicants and registrants who do not receive notice of any other action taken by the Office. As noted above, it is reasonable to expect some notice or acknowledgement from the USPTO regarding action on a pending matter within six months of the filing of a document. A registrant who has not received a notice or acknowledgement from the USPTO regarding a post-registration maintenance, renewal, or amendment document within that time frame has the burden of inquiring as to the status of the USPTO's action on the filing, and requesting in writing that corrective action be taken when necessary, to protect third parties who may be harmed by reliance on inaccurate information regarding the status of its registration in the trademark electronic records system.

Maintain Pendency: The USPTO proposes changes to § 2.66 to prevent applicants from utilizing the revival process to delay prosecution by repeatedly asserting non-receipt of an Office action or notice of allowance. Specifically, the regulations at § 2.66(b) are amended to clarify that a response to the outstanding Office action is required or, if the applicant asserts it did not receive the Office action, that the applicant may not assert more than once that the unintentional delay is based on non-receipt of the same Office action. The USPTO also adds § 2.66(b)(3)(i)-(ii) to clarify the requirements for requesting revival when the abandonment occurred after a final Office action.

An application is considered to be abandoned as of the day after the date on which a response to the Office action or notice of allowance is due. However, to accommodate timely mailed paper submissions and to ensure that the required response was not received and placed in the record of another application (e.g., if the applicant enters the incorrect serial number on its response), the USPTO generally waits until one month after

the due date to send the notice of abandonment and update the trademark electronic records system to indicate that the application is abandoned.

In some situations, an application will become abandoned multiple times for failure to respond to an Office action or notice of allowance and the applicant will assert that it did not receive the same Office action or the notice of allowance each time that it petitions to revive the application. Under the proposed regulations at § 2.66(b), the Office would limit the applicant's ability to assert more than once that the unintentional delay is based on non-receipt of the same Office action. When an applicant becomes aware that its application has been abandoned, either via receipt of a notice of abandonment or after checking the status of the application, the applicant is thereby on notice that the Office has taken action on the application. If the applicant then files a petition to revive an application held abandoned for failure to respond to an Office action which states that the applicant did not receive the action, and the petition is granted, the USPTO will issue a new Office action, if there are additional issues since the original Office action was sent, and provide the applicant with a new six-month response period. If all issues previously raised remain the same, after reviving the application, the USPTO will send a notice to the applicant directing the applicant to view the previously issued Office action in the electronic file for the application available on the USPTO's website and provide the applicant with a new six-month response period. When a petition to revive an application for failure to respond to a notice of allowance states that the applicant did not receive the notice, and the petition is granted, the USPTO will cancel the original notice of allowance and issue a new notice, giving the applicant a new six-

month period in which to file a statement of use or request for extension of time to file a statement of use.

In either situation, the USPTO sends the new Office action or notice of allowance to the correspondence address of record. In general, under the current regulations at 37 CFR 2.18, the owner of an application has a duty to maintain a current and accurate correspondence address with the USPTO, which may be either a physical or e-mail address. If the correspondence address changes, the USPTO must be promptly notified in writing of the new address. If the correspondence address has not changed in the USPTO records since the filing of the application, the applicant is on notice that documents regarding its application are being sent to that address by virtue of its awareness of the abandonment of the application and its subsequent filing of the petition to revive.

Allowing an applicant who is on notice that the Office has taken action in an application to continually assert non-receipt of the same Office action or notice of allowance significantly delays prosecution of the application. It also results in uncertainty for the public, which relies on the trademark electronic records system to determine whether a chosen mark is available for use or registration. Therefore, because the applicant is on notice that documents regarding its application are being sent to the address of record, this proposed rule would limit an applicant to asserting only once that the unintentional delay is based on non-receipt of the same Office action or notice of allowance. If the correspondence address has changed since the filing of the application, the applicant is responsible for updating the address, as noted above, so that any further Office actions or notices will be sent to the correct address.

Codify Requirements for Reinstatement: The USPTO proposes new regulations at § 2.64 to codify the requirements for seeking reinstatement of an application that was abandoned or a registration that was cancelled or expired due to Office error. The proposed regulations indicate that there is no fee for requesting reinstatement. They also set out the deadlines for submitting such requests, as discussed under the heading “Establish Certainty Regarding Timeliness,” and the nature of proof necessary to support an allegation of Office error in the abandonment of the relevant application or cancellation of the relevant registration. Further, the proposed regulation provides an avenue for requesting waiver of the requirements if the applicant or registrant is not entitled to reinstatement.

The rationale for the proposed changes to the deadline for requesting reinstatement of a registration when the registrant did not receive a notice of cancellation is discussed above. The TMEP currently sets out the deadlines for requesting reinstatement of an application or registration that was abandoned, cancelled, or expired due to Office error. TMEP §§ 1712.01, 1712.02(a). Other requirements, such as the nature of proof required to establish Office error, are also set out in the TMEP. However, although the TMEP sets out the deadlines and guidelines for submitting and handling requests for reinstatement, it does not have the force of law. Codifying the deadlines for filing a request for reinstatement in a separate rule that also lists the types of proof necessary to warrant such remedial action would provide clear and definite standards regarding an applicant’s or registrant’s burden. It would also furnish the legal underpinnings of the Office’s authority to grant or deny a request for reinstatement as

well as provide applicants and owners of registrations with the benefit of an entitlement to relief when the standards of the rules are met.

If an applicant or registrant is found not to be entitled to reinstatement, the proposed rule also provides a possible avenue of relief in that the request may be construed as a petition to the Director under § 2.146 or a petition to revive under § 2.66, if appropriate. In addition, if the applicant or registrant is unable to meet the timeliness requirement for filing the request, the proposed rule provides that the applicant or registrant may submit a petition to the Director under § 2.146(a)(5) to request a waiver of that requirement.

Summary of Major Provisions: As stated above, the USPTO proposes to revise the rules in part 2 of title 37 of the Code of Federal Regulations to clarify the requirements for seeking revival of an abandoned application, reinstatement of an application or registration, or submitting a petition to the Director to take some other action.

Discussion of Proposed Regulatory Changes

The USPTO proposes to add § 2.64 and to amend §§ 2.66 and 2.146 to clarify the requirements for submitting petitions to revive an abandoned application and petitions to the Director regarding other matters, as described in the section-by-section analysis below.

The USPTO proposes to add § 2.64 to codify the requirements for requests to reinstate an application that was abandoned, or a registration that was cancelled or expired, due to Office error.

The USPTO proposes to amend the title of § 2.66 to “Revival of applications abandoned in full or in part due to unintentional delay.”

The USPTO proposes to amend § 2.66(a) by adding the title “Deadline” and the wording “in full or in part” and “by not later than;” to amend § 2.66(a)(1) by indicating that the deadline is not later than two months after the issue date of the notice of abandonment in full or in part; and to amend § 2.66(a)(2) by revising the deadline if the applicant did not receive the notice of abandonment.

The USPTO proposes to amend § 2.66(b) by adding the title “Petition to Revive Application Abandoned in Full or in Part for Failure to Respond to an Office Action” and rewording the paragraph for clarity and to add “in full or in part”; revising § 2.66(b)(3) to clarify that a response to the outstanding Office action is required or, if the applicant asserts it did not receive the Office action, that the applicant may not assert more than once that the unintentional delay is based on non-receipt of the same Office action; and adding § 2.66(b)(3)(i)-(ii) to set out the requirements for requesting revival when the abandonment occurs after a final Office action.

The USPTO proposes to amend § 2.66(c) by adding the title “Petition to Revive Application Abandoned for Failure to Respond to a Notice of Allowance;” adding § 2.66(c)(2)(i)-(iv) to incorporate and further clarify requirements in current §§ 2.66(c)(4) and (5); deleting current § 2.66(c)(3)-(4); and redesignating current § 2.66(c)(5) as § 2.66(c)(3) and deleting the wording prior to “the applicant must file.”

The USPTO proposes to amend § 2.66(d) by adding the title “Statement of Use or Petition to Substitute a Basis May Not Be Filed More Than 36 Months After Issuance of the Notice of Allowance” and rewording the paragraph for clarity.

The USPTO proposes to delete current § 2.66(e).

The USPTO proposes to redesignate current § 2.66(f) as § 2.66(e), add the title “Request for Reconsideration,” reword the paragraph for clarity, and revise paragraphs (1) and (2) to clarify the requirements for requesting reconsideration of a petition to revive that has been denied.

The USPTO proposes to amend § 2.146(b) by deleting the wording “considered to be.”

The USPTO proposes to amend § 2.146(d) by deleting the current paragraph and adding a sentence introducing new § 2.146(d)(1)-(2)(iii), which sets out the deadlines for filing a petition.

The USPTO proposes to amend § 2.146(e)(1) by changing the wording “within fifteen days from the date of issuance” and “within fifteen days from the date of service” to “by not later than fifteen days after the issue date” and “by not later than fifteen days after the date of service.” The USPTO proposes to amend § 2.146(e)(2) by changing the wording “within thirty days after the date of issuance” and “within fifteen days from the date of service” to “by not later than thirty days after the issue date” and “by not later than fifteen days after the date of service.”

The USPTO proposes to delete current § 2.146(i).

The USPTO proposes to redesignate current § 2.146(j) as new § 2.146(i), to delete the wording “the petitioner,” and to revise paragraphs (1) and (2) to clarify the requirements for requesting reconsideration of a petition to revive that has been denied.

Rulemaking Considerations

Administrative Procedure Act: The changes in this proposed rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See Perez v. Mortg. Bankers Ass’n, 135 S. Ct. 1199, 1204 (2015) (interpretive rules “advise the public of the agency’s construction of the statutes and rules which it administers”) (citation and internal quotation marks omitted); Nat’l Org. of Veterans’ Advocates v. Sec’y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive); Bachow Commc’ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims).

Accordingly, prior notice and opportunity for public comment for the changes in this proposed rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See Perez, 135 S. Ct. at 1206 (notice-and-comment procedures are required neither when an agency “issue[s] an initial interpretive rule” nor “when it amends or repeals that interpretive rule”); Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice,” quoting 5 U.S.C. 553(b)(A)).

Regulatory Flexibility Act: Under the Regulatory Flexibility Act (RFA) (5 U.S.C. 601 et seq.), whenever an agency is required by 5 U.S.C. 553 (or any other law) to publish a notice of proposed rulemaking (NPRM), the agency must prepare and make available for public comment an Initial Regulatory Flexibility Analysis, unless the agency

certifies under 5 U.S.C. 605(b) that the proposed rule, if implemented, will not have a significant economic impact on a substantial number of small entities. 5 U.S.C. 603, 605.

For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that this rule will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

This proposed rule would amend the regulations to provide detailed deadlines and requirements for petitions to revive an abandoned application and petitions to the Director regarding other matters, and to codify USPTO practice regarding requests for reinstatement of abandoned applications and cancelled or expired registrations. The proposed rule will apply to all persons seeking a revival or reinstatement of an abandoned trademark application or registration, or other equitable action by the Director. Applicants for a trademark are not industry specific and may consist of individuals, small businesses, non-profit organizations, and large corporations. The USPTO does not collect or maintain statistics on small- versus large-entity applicants, and this information would be required in order to determine the number of small entities that would be affected by the proposed rule.

The burdens to all entities, including small entities, imposed by these rule changes will be minor procedural requirements on parties submitting petitions to revive an abandoned application and petitions to the Director regarding other matters, and those submitting requests for reinstatement of abandoned applications and cancelled or expired registrations. The proposed changes do not impose any additional economic burden in

connection with the proposed changes as they merely clarify existing requirements or codify existing procedures.

Executive Order 12866 (Regulatory Planning and Review): This proposed rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule changes; (2) tailored the rules to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

Executive Order 13132 (Federalism): This proposed rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

Unfunded Mandates Reform Act of 1995: The changes in this proposed rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

Paperwork Reduction Act: This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). The

collection of information involved in this rule has been reviewed and previously approved by OMB under control numbers 0651-0051, 0651-0054, and 0651-0061.

You may send comments regarding the collections of information associated with this rule, including suggestions for reducing the burden, to (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW, Washington, DC 20503, Attention: Nicholas A. Fraser, the Desk Officer for the United States Patent and Trademark Office; and (2) The Commissioner for Trademarks, by mail to P.O. Box 1451, Alexandria, VA 22313-1451, attention Catherine Cain; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, VA 22314, attention Catherine Cain; or by electronic mail message via the Federal eRulemaking Portal. All comments submitted directly to the USPTO or provided on the Federal eRulemaking Portal should include the docket number (PTO-T-2010-0016).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

For the reasons stated in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the Office proposes to amend part 2 of title 37 as follows:

PART 2 - RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR Part 2 continues to read as follows:

Authority: 15 U.S.C. 1113, 15 U.S.C. 1123, 35 U.S.C. 2, Section 10(c) of Pub. L. 112–29, unless otherwise noted.

2. Add § 2.64 to read as follows:

§ 2.64 Reinstatement of applications and registrations abandoned, cancelled, or expired due to Office error.

(a) *Request for Reinstatement of an Abandoned Application.* The applicant may file a written request to reinstate an application abandoned due to Office error. There is no fee for a request for reinstatement.

(1) *Deadline.* The applicant must file the request by not later than:

(i) Two months after the issue date of the notice of abandonment; or

(ii) Two months after the date of actual knowledge of the abandonment and not later than six months after the date the trademark electronic records system indicates that the application is abandoned, where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of abandonment.

(2) *Requirements.* A request to reinstate an application abandoned due to Office error must include:

(i) Proof that a response to an Office action, a statement of use, or a request for extension of time to file a statement of use was timely filed and a copy of the relevant document;

(ii) Proof of actual receipt by the Office of a response to an Office action, a statement of use, or a request for extension of time to file a statement of use and a copy of the relevant document;

(iii) Proof that the Office processed a fee in connection with the filing at issue and a copy of the relevant document;

(iv) Proof that the Office sent the Office action or notice of allowance to an address different than that designated by the applicant as the correspondence address; or

(v) Other evidence, or factual information supported by a declaration under § 2.20 or 28 U.S.C. 1746, demonstrating Office error in abandoning the application.

(b) *Request for Reinstatement of Cancelled or Expired Registration.* The registrant may file a written request to reinstate a registration cancelled or expired due to Office error. There is no fee for the request for reinstatement.

(1) *Deadline.* The registrant must file the request by not later than:

(i) Two months after the issue date of the notice of cancellation/expiry; or

(ii) Two months after the date of actual knowledge of the cancellation/expiry and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired, where the registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of cancellation/expiry or the Office did not issue a notice.

(2) *Requirements.* A request to reinstate a registration cancelled/expired due to Office error must include:

(i) Proof that an affidavit or declaration of use or excusable nonuse, a renewal application, or a response to an Office action was timely filed and a copy of the relevant document;

(ii) Proof of actual receipt by the Office of an affidavit or declaration of use or excusable nonuse, a renewal application, or a response to an Office action and a copy of the relevant document;

(iii) Proof that the Office processed a fee in connection with the filing at issue and a copy of the relevant document;

(iv) Proof that the Office sent the Office action to an address different than that designated by the registrant as the correspondence address; or

(v) Other evidence, or factual information supported by a declaration under § 2.20 or 28 U.S.C. 1746, demonstrating Office error in cancelling/expiring the registration.

(c) *Request for Reinstatement May be Construed as Petition.* If an applicant or registrant is not entitled to reinstatement, a request for reinstatement may be construed as a petition to the Director under § 2.146 or a petition to revive under § 2.66, if appropriate. If the applicant or registrant is unable to meet the timeliness requirement under paragraphs (a)(ii) or (b)(ii) for filing the request, the applicant or registrant may submit a petition to the Director under § 2.146(a)(5) to request a waiver of the rule.

3. Revise § 2.66 to read as follows:

§ 2.66 Revival of applications abandoned in full or in part due to unintentional delay.

(a) *Deadline.* The applicant may file a petition to revive an application abandoned in full or in part because the applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition by not later than:

(1) Two months after the issue date of the notice of abandonment in full or in part;
or

(2) Two months after the date of actual knowledge of the abandonment and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part, where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of abandonment.

(b) *Petition to Revive Application Abandoned in Full or in Part for Failure to Respond to an Office Action.* A petition to revive an application abandoned in full or in part because the applicant did not timely respond to an Office action must include:

- (1) The petition fee required by § 2.6;
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and
- (3) A response to the Office action, signed pursuant to § 2.193(e)(2), or a statement that the applicant did not receive the Office action. The applicant may only assert once that the unintentional delay is based on non-receipt of the same Office action.

When the abandonment is after a final Office action, the response is treated as a request for reconsideration under § 2.63(b)(3) and the applicant must also file:

(i) A notice of appeal to the Trademark Trial and Appeal Board under § 2.141 or a petition to the Director under § 2.146, if permitted by § 2.63(b)(2)(iii); or

(ii) A statement that no appeal or petition is being filed from the final refusal(s) or requirement(s).

(c) *Petition to Revive Application Abandoned for Failure to Respond to a Notice of Allowance.* A petition to revive an application abandoned because the applicant did not timely respond to a notice of allowance must include:

(1) The petition fee required by § 2.6;

(2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the statement of use (or request for extension of time to file a statement of use) on or before the due date was unintentional; and one of the following:

(i) A statement of use under § 2.88, signed pursuant to § 2.193(e)(1), and the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(ii) A request for an extension of time to file a statement of use under § 2.89, signed pursuant to § 2.193(e)(1), and the required fees for the number of requests for extensions of time to file a statement of use that the applicant should have filed under § 2.89 if the application had never been abandoned;

(iii) A statement that the applicant did not receive the notice of allowance and a request to cancel said notice and issue a new notice. The applicant may only assert once that the unintentional delay is based on non-receipt of the notice of allowance; or

(iv) In a multiple-basis application, an amendment, signed pursuant to § 2.193(e)(2), deleting the section 1(b) basis and seeking registration based on section 1(a) and/or section 44(e) of the Act.

(3) The applicant must file any further requests for extensions of time to file a statement of use under § 2.89 that become due while the petition is pending, or file a statement of use under § 2.88.

(d) *Statement of Use or Petition to Substitute a Basis May Not Be Filed More Than 36 Months After Issuance of the Notice of Allowance.* In an application under section 1(b) of the Act, the Director will not grant a petition under this section if doing so would permit an applicant to file a statement of use, or a petition under § 2.35(b) to substitute a basis, more than 36 months after the issue date of the notice of allowance under section 13(b)(2) of the Act.

(e) *Request for Reconsideration.* If the Director denies a petition to revive under this section, the applicant may request reconsideration, if:

(1) The applicant files the request by not later than:

(i) Two months after the issue date of the decision denying the petition; or

(ii) Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the applicant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and

(2) The applicant pays a second petition fee under § 2.6.

4. Revise § 2.146 to read as follows:

§ 2.146 Petitions to the Director.

(a) Petition may be taken to the Director:

(1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(a) and (b);

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;

(3) To invoke the supervisory authority of the Director in appropriate circumstances;

(4) In any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; or

(5) In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner

qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed by not later than:

(1) Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or

(2) Where the applicant or registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the action or no action was issued, the petition must be filed by not later than:

(i) Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part;

(ii) Two months after the date of actual knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired; or

(iii) Two months after the date of actual knowledge of the denial of certification of an international application under § 7.13(b) and not later than six months after the trademark electronic records system indicates that certification is denied.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed by not later than fifteen days after the issue date of the grant or denial of the request. A petition from the grant of a request must be served on the

attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided by § 2.119. The potential opposer or the applicant, as the case may be, may file a response by not later than fifteen days after the date of service of the petition and must serve a copy of the response on the petitioner, with proof of service as provided by § 2.119. No further document relating to the petition may be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed by not later than thirty days after the issue date of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, by not later than fifteen days after the date of service of the petition. Petitions and responses to petitions, and any documents accompanying a petition or response under this subsection, must be served on every adverse party pursuant to § 2.119.

(f) An oral hearing will not be held on a petition except when considered necessary by the Director.

(g) The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board, nor stay the period for replying to an Office action in an application, except when a stay is specifically requested and is granted or when §§ 2.63(a) and (b) and 2.65(a) are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Director.

- (i) If the Director denies a petition, the petitioner may request reconsideration, if:
 - (1) The petitioner files the request by not later than:
 - (i) Two months after the issue date of the decision denying the petition; or
 - (ii) Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the petitioner declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and
 - (2) The petitioner pays a second petition fee under § 2.6.

Dated: October 21, 2016

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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